

Appl. No. : 10/690,736
Filed : October 21, 2003
Amdt. Dated : January 21, 2005

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REMARKS/ARGUMENTS

The Applicants thank the Examiner for the Examiner's examination of the present application. By way of summary, Claims 1-51 were previously pending. Claims 1, 3-4, 9-10, 12, 16, 20, 27, 31-32, 37, 44, 47, and 49-51 have been amended. Claims 2, 5-8, 11, 13-15, 17-19, 21-26, 28-30, 33-36, 38-43, and 45-46 remain as originally filed. Claim 48 remains as previously presented. Accordingly, Claims 1-51 remain pending for consideration. In response to the Office Action, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the amendments set forth, the terminal disclaimer filed herewith, the declaration under 35 C.F.R. § 1.131 also filed herewith, and the following arguments.

A. Discussion of Claim Rejections Under 35 U.S.C. § 112

The Office Action rejected Claims 3, 9-11, and 27-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended Claims 3, 9, 27, and 31. These claim amendments do not alter the scope of the claims and are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Accordingly, Applicants respectfully submit that Claims 3, 9-11, and 27-31 are not indefinite; and Applicants respectfully request that the rejection of Claims 3, 9-11, and 27-31 under 35 U.S.C. § 112, second paragraph, be withdrawn.

B. Discussion of Claim Objections Under Double Patenting

1. Claim 51

The Office Action rejected Claim 51 under 35 U.S.C. § 101 as being a substantial duplicate of Claim 48. Applicants have amended Claim 51 to overcome this rejection. This claim amendment is not made for patentability purposes, and it is believed that the claim would satisfy the statutory requirements for patentability without the entry of such amendment. Accordingly, Applicants respectfully submit that amended Claim 51 is not a substantial duplicate of Claim 48; and Applicants respectfully request that the rejection of Claim 51 under 35 U.S.C. § 101 be withdrawn.

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2. Claims 44-45

The Office Action rejected Claims 44-45 under 35 U.S.C. § 101 as non-statutory, double patenting for claiming the same invention as that of Claims 58 and 59, respectively, of U.S. Patent No. 6,671,807. While the Applicants do not agree with the foregoing rejection, in order to progress the prosecution of the present application, the Applicants have attached herewith an appropriate Terminal Disclaimer. Accordingly, the Applicants respectfully request that the rejection of Claims 44-45 under 35 U.S.C. § 101 as a non-statutory, double patenting be withdrawn.

3. Claims 1-11

The Office Action rejected Claims 1-11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 and 8-14, respectively, of U.S. Patent No. 6,671,807. While the Applicants do not agree with the foregoing rejection, in order to progress the prosecution of the present application, the Applicants have attached an appropriate Terminal Disclaimer. Accordingly, the Applicants respectfully request that the rejection of Claims 1-11 under the doctrine of obviousness-type double patenting be withdrawn.

C. Discussion of Claim Rejections Under 35 U.S.C. § 102

The Office Action rejected Claims 12-51 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,134,243, issued to Jones et al. ("Jones"). Applicants respectfully disagree with the Examiner's rejection and respectfully traverse this rejection because Jones fails to identically teach every element of Claims 12-51. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

The Examiner stated, however, that the Applicants may overcome the rejections based on Jones by filing the declaration under 37 C.F.R. § 1.131 that was filed on April 11, 2002 in the parent application, Application No. 09/175,208, issued as U.S. Patent No. 6,487,663.

Accordingly, Applicants note that the Jones patent was filed on August 25, 1998 and claims the benefit of the filing date of U.S. Provisional Patent Application Ser. No. 60/071,556, which was filed on January 15, 1998. Without agreeing with the Examiner's rejection of Claims 12-51 under 35 U.S.C. § 102(e), Applicants submit

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herewith the Declaration under 35 C.F.R. § 1.131 ("Declaration"), filed in the parent case of Application No. 09/175,208 establishing inventorship in the United States prior to the effective date of Jones.

The Declaration is that of Dr. Mysore Y. Jaisimha and Mr. Phillip Barrett, the inventors on the present application. The Declaration, including Appendices A and B, attached hereto, demonstrate Applicants' reduction to practice of the invention prior to the January 15, 1998 effective date of the Jones patent. Therefore, Applicants respectfully submit that Claims 12-51 are in condition for allowance; and Applicants respectfully request that the rejection of Claims 12-51 under 35 U.S.C. § 102(e) be withdrawn.

D. Additional Amendments

Applicants have amended Claims 1, 4, 9, 10, 12, 16, 20, 27, 32, 37, 44, 47, 49, and 50. These claim amendments do not alter the scope of the claims and are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Accordingly, Applicants respectfully submit that Claims 1, 4, 9, 10, 12, 16, 20, 27, 32, 37, 44, 47, 49, and 50 are in condition for allowance.

E. Conclusion

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefore, and arguments in support of the patentability of the pending claims are presented above. In light of the above amendments, the terminal disclaimer filed herewith, the declaration under 35 C.F.R. § 1.131 also filed herewith, and remarks, Applicants specifically request reconsideration and withdrawal of the outstanding rejections. Applicants respectfully request the Examiner to withdraw the rejection(s) of Claims 1-51 and to pass Claims 1-51 to allowance. If the Examiner has any questions, Applicants invite the Examiner to call the undersigned directly.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 21, 2005

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